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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/709,230  
Filing Date: April 22, 2004  
Appellant(s): DOEBERL ET AL.

\_\_\_\_\_  
George M. Macdonald  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11.28.2008 appealing from the Office action mailed 05.20.2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**NEW GROUND(S) OF REJECTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1, 11, and 17** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

**As per Claims 1, 11, and 17**, Examiner asserts that said method steps could be performed by merely mental steps (e.g. can be performed by mental process or human intelligence alone). Here, Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process.

**Claims 2-10, 12-16, and 18-20** are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, based on their dependency on claims 1, 11, and 17 respectively.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 7,315,887	Liang et al.	01-2008
US 6,952,680	Melby et al.	10-2005

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 101***

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**Claims 1, 11, and 17** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] a §101

Art Unit: 3687

statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

**As per Claims 1, 11, and 17**, Examiner asserts that said method steps could be performed by merely mental steps (e.g. can be performed by mental process or human intelligence alone). Here, Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process.

**Claims 2-10, 12-16, and 18-20** are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, based on their dependency on claims 1, 11, and 17 respectively.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-20** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, and 11-24 of copending Application No. 10/249,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Melby et al. [US 6,952,680], and further in view of Liang et al. [US 7,315,887 B1].

**As per claims 1-6, 8-11, and 13-20**, Melby discloses a method for providing asset placement analysis for an organization comprising:

obtaining historical asset usage data over a plurality of periods for a plurality of assets [see abstract (e.g. provide historical trends), and column 2: lines 1-5 (e.g.

***historical access to the information associated with asset usage***)];

obtaining asset physical placement data associated with the plurality of assets over the plurality of periods [see column 14: lines 32-36 (e.g. a pre-determined usage-pricing matrix)]; and

determining suggested alternate asset physical placement data using the asset usage data and the asset physical placement data, and providing the suggested alternate asset physical placement data [see column 3: lines 16-20, via database 78, and via analysis controller 13, read as "***such identification information included, for***

***example, data regarding the make, model, year, and serial number of the asset 11"]***.

Melby discloses all the elements per claimed invention as explained above. Melby does not explicitly disclose a “*physical*” placement analysis for an organization. However, Liang discloses a physical placement analysis management for facilitating integration of communications network equipment or asset inventory management [see abstract, and as illustrated in figure 1 (e.g. blocks 120 and 155)].

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Liang to the teaching of Melby in order to provide a method for facilitating the management of a communication network asset item, a physical placement analysis of an asset item for an organization, and a system-readable identification enables the physical asset manager to create the informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item [see summary of the invention].

**As per claims 7 and 12**, Melby discloses obtaining department data for a plurality of departments of the organization associated with the asset placement data specifying a plurality of locations each associated with the plurality of assets [see abstract (e.g. provide historical trends), and column 2: lines 1-5 (e.g. ***historical access to the information associated with asset usage***)];

determining peak usage for at least one of the departments using the historical asset usage data, the department data and the asset placement data [as illustrated in

Art Unit: 3687

figure 6, **a flow chart of a sub-system illustrating the analysis of asset-related information to determine responsibility and peak usage for asset utilization**]; and suggesting at least one replacement asset for the at least one department [see paragraph bridging column 17 and 18 (e.g. **the system to automatically order replacement parts for an inventory location**)].

Melby discloses all the elements per claimed invention as explained above. Melby does not explicitly disclose “*physical*” asset placement data, and “*physical*” location. However, Liang discloses a “*physical*” asset placement data, and “*physical*” location [see abstract, and as illustrated in figure 1 (e.g. blocks 120 and 155)].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Liang to the teaching of Melby. The motivation is the same as claims 1-6, 8-11, 13-20 above.

#### **(10) Response to Argument**

Appellants’ arguments have been fully considered but they are not persuasive. Appellants argue that Melby does not disclose “a replacement asset analysis and no suggestion of modeling a replacement asset costs based upon usage data collected for the installed asset”. The Examiner respectfully disagrees.

In response to Appellants’ argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., **modeling a replacement asset cost**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

Art Unit: 3687

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

However, Melby discloses a computer based system that automatically gathers, analyzes, and delivers information relating to the procurement and utilization of a **plurality of such assets**, such as a **fleet of industrial equipment** (see abstract), and a plurality of **stationary machines** used in a manufacturing environment (see paragraph bridging columns 7 and 8).

Furthermore, Liang discloses a physical asset management system that is capable of carrying-out a method for facilitating integration of communications network equipment inventory management. Liang further discloses a method that includes assigning system-readable identification to an asset item of a communication network, receiving the system-readable identification of the asset item at a physical asset manager in response to installing the asset item in the communication network, and creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item. The system-readable identification is enabling the physical asset manager to create the informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item.

Appellant also argue that Melby does not discloses or suggest taking historical usage data over a plurality of periods. The Examiner respectfully disagrees. Melby discloses a remote analysis system that automatically analyzes newly provided information and schedules maintenance as required. Information that is associated with the maintenance is also recorded electronically to maximize efficiency, **provide**

**historical trends**, automate billing, and control inventory levels (see abstract, and column 2: lines 1-15).

Appellants further that Melby does not disclose "using a best fit algorithm". The Examiner respectfully disagrees. Melby discloses a conventional error checking algorithm that can be used to confirm a best fit or accuracy and completeness (see column 7: lines 50-53).

In response to applicant's argument that the references are not properly combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the references are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. It is necessary to consider the reality of the circumstances, in other words, common sense in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Wood*, 599 F.2d 1032, 1036, (C.C.P.A. 1979). A reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as basis of rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately. The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

**(2) Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

Art Unit: 3687

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Garcia Ade

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/Wynn W. Coggins/

Group Director, TC 3600

Conferees:

/Matthew S Gart/

Application/Control Number: 10/709,230

Page 15

Art Unit: 3687

Supervisory Patent Examiner, Art Unit 3687

/Vincent Millin/

Appeals Practice Specialist